BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

OPINION OF THE COURT BELOW.

The opinion of the United States Court of Customs and Patent Appeals (Judge Lenroot writing) is reported at 109 F. (2d) 789 and appears at pages 575 to 595 of the record. The portion of the opinion addressed to the matter presented by this Petition extends from page 6 (R. 580) to page 14 (R. 585).

JURISDICTION.

Judgment of the Court of Customs and Patent Appeals was entered February 26, 1940.

The jurisdiction of this Court is invoked under Sections 195 and 240-A of the Judicial Code, Title 28, United States Code, Sections 308 and 347 (Rules 42 and 38).

While this Court held in Postum Cereal Company v. California Fig Nut Company, 272 U. S. 693, that it had no jurisdiction to review a trade-mark opposition proceeding upon certiorari, and while it has been ably argued that this Court has no jurisdiction to grant certiorari to review decisions of the Court of Customs and Patent Appeals in *ex parte* appeals from the Patent Office (see Keller v. Coe, No. 789, 1935 Term, Brief in Opposition to Certiorari by the then Solicitor-General, now Mr. Justice Reed), this Court has never held that it had no such jurisdiction in patent interference proceedings, as to which the reasoning of Postum Cereal Company v. California Fig Nut Company does not apply. Such reasons will be presented *in extenso* under "Argument."

STATEMENT OF THE CASE.

The material facts necessary for an understanding of the matter presented in this Petition are:

(a) That Petitioner filed an application for Letters Patent on November 14, 1930, and that the Court of Appeals has held that said application fully disclosed the subject matter involved here. The application of Petitioner immediately involved in this interference was filed November 5, 1934.

(b) That Respondent Teeple filed an application for Letters Patent on February 4, 1931, and the Court of Customs and Patent Appeals has held that date to be the earliest date established by Respondent Teeple.

(c) That despite the earlier filing and full disclosure by Petitioner in his application filed November 14, 1930, the Court of Customs and Patent Appeals has refused to hold that Petitioner ante-dated Respondent Teeple.

SPECIFICATION OF ERRORS.

1. That the United States Court of Customs and Patent Appeals erred in holding that when a patent application conceded to constitute a constructive reduction to practice when filed becomes patented it no longer constitutes a constructive reduction to practice as of the filing date, and in that respect the Court of Customs and Patent Appeals failed and refused to follow the decision of this Court in Alexander Milbourne v. Davis-Bournonville, 270 U. S. 390.

2. That the United States Court of Customs and Patent Appeals erred in failing and refusing to award priority of invention of the subject matter of Count 1 to McBride when the Court did rule that McBride had filed an allowable application disclosing the subject matter prior to any date established by Teeple.

ARGUMENT.

I.

THIS PROCEEDING IS JUDICIAL AND NOT MERELY ADMINISTRATIVE IN NATURE, AND THIS COURT HAS CONSTITUTIONAL POWER TO REVIEW SUCH DECISIONS OF THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

The decision of this Court in Postum Cereal Company v. California Fig Nut Co., 272 U. S. 693,[1] is bottomed upon the proposition that the decision of the Court of Appeals for the District of Columbia (which, under the statutes then in force, had jurisdiction of appeals from the Patent Office) was not judicial, but was merely administrative in nature. In trade-mark opposition proceedings, as involved in that case, no **substantive** right of either party was subject to adjudication in any way either by the Court of Appeals or the Patent Office. The case concerned itself solely with an administrative function, namely, the registration of a trade-mark, which in no way affected the substantive rights of anyone.[2]

The situation presented by a patent interference proceeding is definitely distinguishable, however, in that the decision of the United States Court of Customs and Patent

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1 Followed in another trade-mark opposition proceeding, Pacific Northwest Canning Co. v. Skookum Packers' Association, 283 U. S. 858.

2 Section 23 of the Trade-Mark Act of February 20, 1905, provides:
"That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed,"

and the Courts have accordingly held that:

"No right of property is concluded by registration of a mark, and the parties affected are free to seek such relief as the Courts of law or equity may award." Patton Paint Co. v. Sunset Paint Co., 290 Fed. 326, l. c. 328; William Rogers v. International Silverware Co., 30 App. D. C. 97, 105.

Appeals upon the question of priority of invention is controlling upon the parties to the case: Morgan v. Daniels, 153 U. S. 120, l. c. 125; Radio Corp. v. Radio Laboratories, 293 U. S. 1, l. c. 6. It has been held to amount to *res adjudicata:* Shimadzu et al. v. Electric Storage Battery Co., 17 F. Sup. 42, l. c. 49 (reversed on other grounds, 307 U. S. 5); and the same effect has been intimated in other cases, R. Thomas & Sons Co. v. Electric Porcelain & Mfg. Co., 111 F. Rep. 923, l. c. 929; Westinghouse Electric and Manufacturing Co. v. Wadsworth Electric Manufacturing Co., 51 F. (2) 447, l. c. 448.

In the circumstances of the instant case, the Du Pont Company has received a patent for subject matter which, as decided by the Court of Customs and Patent Appeals, was in fact disclosed in a McBride application filed in the United States Patent Office prior to any date established by the Du Pont Company for Teeple. This is an adversary proceeding, and the only one provided by the judicial machinery in this country whereby McBride can recover from the Du Pont Company the patent protection rightfully belonging to him.

The two basic reasons which support this Court's decision in Postum Cereal Company v. California Fig Nut Company, supra, but do not apply to a patent interference proceeding such as the instant case, are:

1. That the thing contested in a trade-mark opposition proceeding under the Trade-Mark Act of 1905, as was the Postum Cereal case, is a mere right to registration which in no way affects the substantive or property rights of either party to the trade-mark in question.

2. That regardless of the outcome of such a trade-mark opposition proceeding, the proceeding cannot prevent, lessen, impeach, or avoid any remedy at law or in equity; and consequently the findings of the

administrative tribunals are neither conclusive nor controlling upon the parties.

As distinguished from the situation created by the Trade-Mark Act of 1905, the decision of the Court of Customs and Patent Appeals in a patent interference case does in fact prevent, lessen, impeach and avoid remedies at law and in equity; and for all practical purposes binds the parties to the case with respect to the adjudicated question—priority of invention—which does affect a substantive property right.

A patent interference proceeding is therefore a case or controversy within the meaning of the Constitution of the United States, and as defined by this Court in such cases as Muskrat v. U. S., 219 U. S. 346; Cohen v. Virginia, 6 Wheaton 264; Marbury v. Madison, 1 Cranch 137; Chisholm v. Georgia, 2 Dallas 431.

In the Muskrat case, supra, this Court quoted Mr. Justice Field with approval as follows:

> "* * * By cases and controversies are intended the claims of litigants brought before the Courts for determination by such regular proceedings as are established by law or custom for the protection or enforcement of rights, or the prevention, redress, or punishment of wrongs. Whenever the claim of a party under the Constitution, laws, or treaties of the United States takes such a form that the judicial power is capable of acting upon it, then it has become a case. The term implies the existence of present or possible adverse parties, whose contentions are submitted to the court for adjudication."

Clearly, the present case falls within the above definition. It is a controversy involving the claim of the litigants before the Courts for determination by regular proceedings established by law for the redress of a wrong,

to wit, the wrongful issuance of a patent to Teeple for the invention covered by Count 1 of the Interference. The claim is definitely under the Constitution and laws of the United States, and is in such form that the judicial power is capable of acting upon it. The parties are decidedly adverse, and their contentions were submitted to the Court below for adjudication.

Furthermore, at the time this Court decided in Postum Cereal Company v. California Fig Nut Company that it had no jurisdiction to review the matter upon certiorari, there was still open to the parties in that case a **judicial** proceeding (under R. S. 4915) whereby the controversy might be litigated, so that in point of fact at that time (but not now)[1] the decision of the United States Court of Customs and Patent Appeals did not constitute a binding judgment upon the parties.

It is therefore believed evident that the *ratio decidiendi* of Postum Cereal Company v. California Fig Nut Company, supra, is not apposite in the case of a patent interference, which is, in reality, a judicial proceeding, and accordingly the Postum case does not establish lack of jurisdiction in the instant case.

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1 At the time of this Court's decision in Postum Cereal Company v. California Fig Nut Company, R. S. 4915 permitted the institution of proceedings in equity subsequent to the decision of a Patent Office Appellate Tribunal (then the Court of Appeals for the District of Columbia), whereas at the present time, by virtue of amendments made to R. S. 4915, March 2, 1927, and March 2, 1929, such proceeding in equity is not available after a decision by the United States Court of Customs and Patent Appeals.

II.

THE DECISION OF THE COURT OF CUSTOMS AND PATENT APPEALS, HOLDING THAT McBRIDE'S APPLICATION FILED NOVEMBER 14, 1930, DISCLOSED THE SUBJECT MATTER AND THAT TEEPLE HAD ESTABLISHED NO DATE PRIOR TO FEBRUARY 4, 1931, ESTABLISHES A SITUATION IN WHICH, AS BETWEEN McBRIDE AND TEEPLE, McBRIDE WAS THE FIRST INVENTOR ACCORDING TO THE DOCTRINE OF ALEXANDER MILBOURNE V. DAVIS-BOURNONVILLE, 270 U. S. 390.

After fully discussing the disclosure of McBride's application filed November 14, 1930, the Court of Customs and Patent Appeals stated (R. 584):

> "It follows from the foregoing that we are in agreement with the Board of Appeals that appellant is entitled to the date of his application (November 14, 1930) upon which his said patent was issued for conception of the invention embraced in count 1.
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> "Appellant, however, contends that he is also entitled to the date of said application for constructive reduction to practice of the invention. The board held against appellant upon this point upon the ground that there was a hiatus between the time of issue of appellant's patent upon his early application and upon the time of filing of appellant's application here involved, and that he was not entitled to the date of said early application for constructive reduction to practice of the invention.
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> "In support of his contention appellant relies largely upon our decision in the case of **Wiley v. Mears et al.**, 22 C. C. P. A. (Patents) 986, 75 F. (2d) 510, while appellee relies upon our decision in the case of **Conover v. Downs**, 17 C. C. P. A. (Patents) 587, 35 F. (2d) 59,

in support of the contrary conclusion reached by the board.

"An examination of **these two cases**[1] discloses that they appear to be **in conflict** in that in the **Wiley v. Mears et al.** case, supra, an earlier application was held to constitute a constructive reduction to practice with respect to certain counts although there was lack of continuity in the applications, while in **Conover v. Downs**, supra, a contrary view was expressed."

(l. c. 14) R. 585:

"In any event, as hereinbefore stated, we adhere to the views expressed in **Conover v. Downs**, supra, and hold that while appellant is entitled to the date of his early application, November 14, 1930, for conception of the invention embraced in count 1, that application did not constitute a constructive reduction to practice of the same."

It is thus recognized by the Court of Appeals that **its decisions**, upon the question here presented, **are in conflict with each other**; and while its more recent decision, Wiley v. Mears, supports[1] the contention of Petitioner here, its earlier decision, Conover v. Downs, was contrary thereto. In its decision in the instant case the Court below readopted the views expressed in Conover v. Downs, although it was urged (Petition for Rehearing, pp. 5-11, R. ...) that the decision was in direct conflict with the holding of this Court with respect to reduction to practice in Milburn v. Davis-Bournonville.

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1 Emphasis in quotations supplied throughout unless otherwise indicated.

1 **"As a matter of law, if the disclosures of the Wiley application of May 10, 1928, which ripened into his patent of November 11, 1930, support the counts, Wiley is entitled to the award of priority in view of the evidence in the case."** 75 F. (2), l. c. 513.

The date of reduction to practice of an invention is the date upon which the invention is completed, and generally[2] the date determinative between several inventors as to which was the first to invent the subject matter. Reduction to practice may be established in two ways:

1. Actually (not involved here) by practical, successful test of the thing sought to be patented;

2. Constructively (the situation of both parties here) by the filing of allowable application for patent, disclosing the subject matter sought to be patented.

Whether the reduction to practice be actual or constructive, it must be established in an interference proceeding by **evidence**; but with a constructive reduction to practice, that evidence is already of record in the Patent Office in the form of an application for patent. Succinctly, the question presented here is whether such a piece of evidence which, while an application in the secret archives of the Patent Office, constituted conclusive evidence of such reduction to practice, loses that characteristic when it becomes patented and open to the public.

The case of Alexander Milbourne v. Davis-Bournonville, supra, involved a situation where the plaintiff's patent (Whitford) application was filed in the Patent Office on March 4, 1911, and the patent issued June 4, 1912. Prior to the filing of Whitford's application, one Clifford had filed an application on January 31, 1911, so that both Whitford's and Clifford's applications were co-pending in the Patent Office. The Clifford application disclosed the subject matter patented to Whitford and hence constituted a constructive reduction to practice thereof.

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2 The date of conception, when coupled with reduction to practice by reasonable diligence, is regarded as the legally effective date; but no such situation is involved here.

The factual situation in the instant case is precisely parallel to the factual situation in Milbourne v. Davis-Bournonville. In the instant case Respondent's patent (Teeple) application was filed in the Patent Office February 4, 1931, and the patent issued August 29, 1933. Prior to the filing of Teeple's application McBride had filed an application on November 14, 1930, so that both Teeple's and McBride's applications were co-pending in the Patent Office. That McBride's application disclosed the subject matter patented to Teeple has been held by the tribunals below.

Since, in the Milbourne case, this Court held that the applications of the patentees showed that Clifford had invented the subject matter prior to Whitford:

> "The description (of Clifford) shows that Whitford was not the first inventor. Clifford had done all that he could do to make his description public," (l. c. 401)

so we contend that the applications themselves in this proceeding show that Teeple was not the first inventor; and, as between Teeple and McBride, the applications show that McBride was the prior inventor. In failing so to hold that McBride was the prior inventor to Teeple, the Court of Customs and Patent Appeals has failed to give effect to this Court's decision in Milbourne v. Davis-Bournonville by failing to accord McBride the benefits of his application filed November 14, 1930, as a constructive reduction to practice, although conceding that this application disclosed the subject matter.

McBride's application filed November 14, 1930, did not mature into a patent until April 24, 1934, eight months after the issuance of the patent to Teeple. McBride's application involved in this Interference was filed November 5, 1934, so that neither the Teeple patent nor McBride's

Patent No. 1,955,927 constituted a statutory bar against it. This precise point was covered by this Court's decision in Alexander Milbourne v. Davis-Bournonville, where this Court said (l. c. 401-2):

> "It is said that without a claim the thing described is not reduced to practice. But this seems to us to rest on a false theory helped out by the fiction that by a claim it is reduced to practice. **A new application** and a claim **may be based on the original description within two years,** and the original priority established notwithstanding intervening claims. Chapman v. Wintroath, 252 U. S. 126, 137. **A description that would bar a patent if printed in a periodical or in an issued patent is equally effective in an application so far as reduction to practice goes.**"

Clearly, McBride's application involved in this Interference was such a "new application," and Count 1 of the Interference (the only count involved here) was a claim based on the original description "within two years."

In Conover v. Downs, 35 F. (2) 59, the doctrine of which was readopted by the Court of Customs and Patent Appeals in its decision in the instant case, that Court did discuss this Court's decision in Alexander Milbourne v. Davis-Bournonville, but held that the doctrine of that case was not applicable to an interference proceeding, and made other distinctions not applicable to the instant case.

The only difference between an interference proceeding, such as this case, and a proceeding such as Alexander Milbourne v. Davis-Bournonville (270 U. S. 390, where the defendant attacked the validity of the plaintiff's patent) is that in an interference proceeding one party says to the other that the thing you have patented was first invented by me, rather than saying that the thing you have invented was first invented by a third party. Plainly the **same question of priority of invention** is involved in both pro-

ceedings. The proof necessary to establish prior invention is no different in character in one type of case than in another. The object of the litigation cannot affect the character of proof necessary to establish **priority of invention.**

It would seem plain that if the filing of an allowable application for patent establishes a reduction to practice and thus determines **priority of invention** in one kind of case, as this Court has held in Alexander Milbourne v. Davis-Bournonville, the filing of such an allowable application for patent must constitute proof of the same thing in any other kind of case. The filing of an allowable application is record evidence conclusively establishing a date, and as a piece of evidence such a filed application must speak the same in all proceedings.

Following the theory of Conover v. Downs, such question of priority is determined by one kind of law in an infringement suit, and by a different kind of law in an interference case; but such has not been the practice of the Courts. When this Court was considering an interference case, to wit, Chapman v. Winthroath, 252 U. S. 126, it made the following statement (l. c. 137):

> "To this we must add that not only have later or divisional applications not been dealt with in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that where an invention clearly disclosed in an application, as in this case, is not claimed therein but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date **of the earlier, with all of its priority of right,"**

it cited in support thereof the infringement case of Smith & Griggs Manufacturing Co. v. Sprague, 123 U. S. 249, 250.

The effect of Conover v. Downs, 35 F. (2), and the Court of Customs and Patent Appeals' decision in this case is to say that, while an application is pending in the Patent Office, while it reposes in the secret archives of the Patent Office, it does constitute a constructive reduction to practice; yet when it is laid open to the public, so that the public may know about the disclosure, it no longer constitutes a constructive reduction to practice as of its filing date. In this respect the decision of the Court below is directly contrary to the decision of this Court in Alexander Milbourne v. Davis-Bournonville. Even in that case the application which this Court held to be a constructive reduction to practice as of its filing date had become patented, and despite the fact that it was thus laid open to the public, this Court held that it constituted a reduction to practice, and established that the patentee thereof (Clifford) had invented the subject matter prior to the other contestant, Whitford.

What the Court of Customs and Patent Appeals has done is to say to McBride that, while the record shows that you invented the subject matter first, we will not award priority to you because you have permitted your early application to become patented. What the Court below held in Conover v. Downs, supra, and reaffirmed in this case, is that Supreme Court law may apply in determining the question of **priority of invention** in the other courts, but it does not apply to determinations of that same question—priority of invention—in the Court of Customs and Patent Appeals.

CONCLUSION.

From the foregoing, we submit, that the Court of Customs and Patent Appeals has failed to apply the established law in this case; that priority of invention is a question determined no differently in one kind of case than in

another, and that it is important not only to Petitioner, but to the public, inventors and industry at large that the Court of Customs and Patent Appeals be required to follow the law as established by decisions of this Court.

Wherefore your Petitioner prays that the petition be granted, that writ of certiorari be issued, the cause reviewed to the extent requested, and the judgment of the Court below be modified to award priority of invention as to Count 1 to Petitioner.

Respectfully submitted,

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